

# REMARKS

Claims 1 to 14 are in the case.

With this amendment, Claim 11 has been further amended to positively claim the gutter and gutter shield device including the gutter retaining member and accordingly Claims 11 to 13 are believed to clearly define over the art.

Both Claims 1 and 11 have been amended to change "securing member" to "clip" in line with the terminology used in the disclosure.

Reconsideration of the Examiner's rejection of the claims under 35 USC 102/103 is respectfully requested in view of the following comments.

Initially, the Examiner's comments concerning United States Patent 4,553,356 in his rejection of Claims 1, 2, 7, 8 and 10 to 13 under 35 USC 102 are not understood. The Examiner states that gutter assembly 10 includes gutter 20 with a typically U-shaped cross section. The Examiner has further stated that he considers the gutter leg closest to the structure 14 as the rear wall and the leg farthest from the wall as the front wall with reference numeral 20 pointing to the bottom wall. Applicant fully agrees that the gutter has a U-shaped configuration as do substantially all gutters. However, Applicant has defined in his claims a mounting member and means for securing the mounting member to the gutter. The means for securing comprise a clip member having a pair of legs extending downwardly and means designed to be attached to the gutter retaining member. This is completely different from the arrangement shown in Pepper. Indeed, the gutter retaining member of Pepper is completely different from that shown in the instant application and inherently cannot have the arrangement proposed by Applicant.

The rejections under 35 USC 103 are not believed to be anymore pertinent since the secondary references do not add to the teachings of Pepper regarding the above arguments.

The rejection of Claim 14 under 35 USC 103 as allegedly unpatentable over Pepper in view of Goetz is respectfully traversed. As the Examiner has noted, Pepper does not teach a guard member having a channel extending along elongated sides. Claim 14 calls for the flexible sealing portion for sealing engagement with an adjacent structure to be retained within the channel formed at the first side of the guard member.

Goetz teaches a channel along a first side of his guard member. However, this channel is specifically designed to engage with a similar channel formed on the gutter to thereby hold the guard member in place. Accordingly, it is not seen how it would have been obvious to a person of ordinary skill in the art to use the teachings of Goetz for holding a flexible sealing member as this would be totally contrary to the teachings of the prior art.

As for the proposed combination of references, it is respectfully submitted that since none of the references in the combination teaches the distinctive features of Applicant's invention as defined now in Claim 14, any hypothetical construction produced by this combination would not lead to Applicant's invention.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

There is nothing in the cited art to suggest what Applicant did. In fact, these

references do not even contain any suggestion that they could be combined in the manner proposed by the Examiner. However, this is a prerequisite for a combination rejection, as stated by the Patent Office Board of Appeals in its decision in *Ex parte Walker*, 135 USPQ 195:

*"In order to justify combination of references it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so.*

The Court of Customs and Patent Appeals subscribed to the Board's reasoning, when it handed down its decision in the case *In re Imperato*, 179 USPQ 730, holding:

*"The fact that the disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest the desirability of such a combination.*

*"With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references."*

In fact the art must not only be combinable in accordance with the principles of the above decisions, but to support a valid combination rejection the art must also suggest that the combination would accomplish Applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

*"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicant's*

*result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices."*

It is also well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. Note would be taken in this connection of the decision of the Court of Customs and Patent Appeals *In re Kamm and Young*, 17 USPQ 298 ff, which appears most pertinent to the issues at hand and wherein the claims were also rejected over a combination of references. The court held that:

*"The rejection here runs afoul of a basic mandate inherent in section 103 - that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965)." Emphasis added.*

The mere fact that an invention is simple and accomplishes only a small but genuine improvement is not sufficient reason to deny it patent protection.

*In Schnell et al v. The Allbright-Nell Co. et al*, 146 USPQ 322, the U.S. Court of Customs and Patent Appeals held that

*"Device seems simple and obvious in light of patentee's teaching, but it evidently was not obvious at time of invention; those working in the field did not accomplish patentee's results; that fact supports conclusion that patentee achieved patentable invention."*

The Board of Appeals expressed the same concept when it held, *in Ex parte Grasenick and Gessner*, 158 USPQ 624, that

*"Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious."*

Attention is also directed to *Mercantile National Bank of Chicago et al v. Quest, Inc. et al. D.C., N.D., Indiana*, 166 USPQ 517, *In re Shelby*, 136 USPQ 220, and *In re Irani and Moedritzer*, 166 USPQ 24, which all indicate that simplicity does not operate as a bar to patentability, if the invention was unobvious at the time it was made.

It is respectfully submitted that when the rejection of the claims is reviewed in light of Applicant's arguments, the invention without a doubt should be considered patentably distinguished over the currently applied references.


Respectfully,



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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the Patents and Trademarks Office Fax No. (703) 872-9306 date set forth below.

  
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Date